



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2014-0004]

**Notice of Public Hearings and Extension of Comment Period on the Proposed
Changes to Require Identification of Attributable Owner**

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of public hearings and extension of comment period.

SUMMARY: The United States Patent and Trademark Office (Office) published a notice on January 24, 2014, proposing changes to the rules of practice to require that the attributable owner, including the ultimate parent entity, be identified during the pendency of a patent application and at specified times during the life of a patent, and seeking written comments on the proposed changes. This initiative is one of a number of executive actions issued by the Administration that are designed to ensure issuance of the highest-quality patents, enhance competition by providing the public with more complete information about the competitive environment in which innovators operate, improve

market efficiency for patent rights by making patent ownership information more readily and easily available, reduce abusive patent litigation by helping the public defend itself against frivolous litigation, and level the playing field for innovators. The Office is conducting two public hearings to discuss these proposed changes. The public hearings are an additional way for the Office to introduce the proposed changes and directly receive feedback from the public. The Office also is extending the period for public comment on the proposed changes until April 24, 2014, to provide interested members of the public with additional time to submit written comments.

DATES: PUBLIC HEARING DATES: The first public hearing will take place on March 13, 2014, from 1 p.m. Eastern Daylight Time (EDT) until 4 p.m. EDT, in Alexandria, Virginia.

The second public hearing will take place on March 26, 2014, from 9 a.m. Pacific Daylight Time (PDT) until noon PDT, in San Francisco, California.

REQUESTS TO PROVIDE ORAL TESTIMONY: Those wishing to provide oral testimony at either public hearing must submit a request to do so in writing no later than February 28, 2014. Members of the public who wish to attend solely to observe need not submit a request to attend.

COMMENT DEADLINE DATE: To be ensured of consideration, written comments on the proposed changes to the rules of practice to require identification of the attributable owner must be received on or before April 24, 2014.

ADDRESSES: PUBLIC HEARINGS: The first public hearing will take place at: Madison Auditorium North, Concourse Level, United States Patent and Trademark Office Headquarters, 600 Dulany Street, Alexandria, Virginia 22314.

The second public hearing will take place at: the University of California Hastings College of the Law, Louis B. Mayer Lounge, 198 McAllister Street, San Francisco, California 94102.

REQUESTS TO PROVIDE ORAL TESTIMONY: Requests to provide oral testimony at either public hearing must be sent by electronic mail message over the Internet addressed to: aohearingrequest@uspto.gov.

COMMENTS: Comments should be sent by electronic mail message over the Internet addressed to: AC90.comments@uspto.gov. Comments also may be submitted by postal mail addressed to: Mail Stop Comments-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, marked to the attention of James Engel, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

Comments likewise may be sent by electronic mail message over the Internet via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal.

Although comments may be submitted by postal mail, the Office prefers to receive comments by electronic mail message over the Internet because sharing comments with the public is more easily accomplished. Electronic comments in plain text are preferred, but comments in ADOBE® portable document format or MICROSOFT WORD® format are also acceptable. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format.

Comments will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia. Comments also will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: James Engel, Senior Legal Advisor ((571) 272-7725), or Erin M. Harriman, Legal Advisor ((571) 272-7747), Office of Patent

Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy.

SUPPLEMENTARY INFORMATION: The Office recently published a notice of proposed rulemaking proposing to require the disclosure of ownership information about patents and applications and requesting comments about the voluntary reporting of licensing offers and commitments and making them available online. See [Changes to Require Identification of Attributable Owner](#), 79 FR 4105 (Jan. 24, 2014). The Office is conducting two public hearings to discuss these proposed changes and receive feedback from the public. The Office also is extending the period for public comment on the proposed changes until April 24, 2014, to provide interested members of the public with additional time to submit written comments.

Members of the public who wish to provide oral testimony at either public hearing must submit a timely request (i.e., must submit a request to provide oral testimony no later than February 28, 2014). Requests to provide oral testimony at either public hearing must indicate the following information: (1) The name of the person desiring to speak; (2) the person's contact information (telephone number and electronic mail address); (3) the organization(s) the person represents, if any; and (4) the hearing location where the person prefers to speak. A person must be physically present at the hearing location to provide oral testimony; virtual testimony via telephone or webcast is not available. Based on the requests received, an agenda of scheduled speakers will be sent to those speaking and posted on the Office's Internet Web site at <http://www.uspto.gov>. The

number of speakers and time allotted to each speaker may be limited to ensure that all persons speaking will have a meaningful chance to do so.

Members of the public who wish to attend solely to observe need not submit a request to attend. The Office also plans to make the public hearings available via Web cast. Web cast information will be available on the Office's Internet Web site closer to the public hearing dates. A transcript of the public hearings will be available for viewing via the Office's Internet Web site at <http://www.uspto.gov>, and will be available for public inspection at the Office of the Commissioner for Patents, currently located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia 22314, upon request.

The public is welcome to submit written comments in response to the proposed changes in addition to, or lieu of, presenting oral testimony at these public hearings. The Office is extending the period for public comment on the proposed changes to provide interested members of the public with additional time to submit written comments. Written comments in response to the proposed changes must be received on or before April 24, 2014.

Under the proposed rulemaking, the Office plans to collect information on the "attributable owner" of a patent or application, which includes the titleholders, entities with rights to enforce the patent, and entities with effective control over anyone reported in the first two categories, called the "ultimate parent entities." This information would be made available to the public under the proposed rulemaking at the same time a patent

application is published or when a patent issues. The Office also seeks public comment on whether to permit patent applicants and owners to voluntarily report licensing offers and related information that the Office will make available to the public. The Office currently permits patent owners to request that their patents be listed in the Official Gazette as available for license or sale, and the Office would like public input on whether the Office should expand on this program to allow for the submission of more licensing information and make this information available in an accessible online format.

The Office welcomes comments on all aspects of the proposed rulemaking, but highlights the following areas (which are also highlighted in the notice of proposed rulemaking) for receipt of public input:

(1) The proposal sets forth a definition for attributable owner. The Office invites public comment on whether changes could be made to the scope of the information proposed to be collected while still achieving the objectives of the Office as set forth in the proposal.

(2) Part of the current proposed definition of attributable owner incorporates by reference the definition of ultimate parent entity set forth in 16 CFR 801.1(a)(3). The Office welcomes comments on how this definition might be modified for use at the Office. The Office recognizes that corporations sometimes transfer patents and patent applications within the corporation for legitimate reasons, such as tax savings purposes, and also welcomes comments on the impact of the proposed changes on this practice.

(3) The proposal sets forth when attributable owner information must be supplied to the Office. The Office invites public comments as to whether and when attributable owner information should be collected. For example, are there additional times during prosecution (e.g., with each reply to an Office action) when the applicant should be required to update or verify attributable owner information? Is requiring updates on changes during prosecution within three months of any change in attributable owner the appropriate time frame (i.e., should the time frame be more or less than three months?).

(4) The Office plans to work with its user community to implement the attributable owner information reporting system in a user-friendly manner and welcomes input on how this can best be accomplished. Subject to financial and resource constraints, for example, the Office would like to explore means to allow for the bulk processing of changes to attributable owner for portfolios of applications and patents. The Office also welcomes input on how the updating or verifying by the applicant or owner should be structured in conjunction with the payment of maintenance fees, particularly in light of the practice of outsourcing payment of maintenance fees to third parties.

(5) The Office further seeks comments on whether the Office should expand the current Official Gazette practice of allowing patent owners to list patents as available for license or sale to permit all patent applicants and owners to voluntarily report additional licensing information for the Office to make available to the public in an accessible online format. The Office welcomes input on what such licensing information should include (i.e., willingness to license, as well as licensing contacts, license offer terms,

commitments to license the patent, e.g., on royalty-free or reasonable and non-discriminatory terms) and the interface of the online system.

Date: February 12, 2014

Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office

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